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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,965	12/20/1999	YOSHIHIRO TSUKAMURA	SON-1710	1790

7590 09/11/2003

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EXAMINER

TRAN, TONGOC

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/466,965

Applicant(s)

TSUKAMURA ET AL.

Examiner

Tongoc Tran

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This Office Action is in response to applicant's application No. 09/466965 which was filed on 12/20/1999.

***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/466965, filed on 12/20/1999.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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4. Claims 1-14 are rejected under 35 U.S.C. 102(a) as being anticipated by Pare Jr. et al. (U.S. Patent No. 5,838,812).

5. In respect to claims 1, 6, 9 and 13, Pare teaches a system and method for identify an unknown user with a unique biometrics sample previously stored and can be networked between other computer systems carrying out all necessary executions (see abstract).

“the host computer comprising:

input means for inputting a user's instruction;

command output means for generating from the user's instruction an instruction command which request a predetermined processing to be executed and for outputting it; and communication means for communicating with an external unit” (see col. 11, lines 28-35, col. 18, lines 5-27); and

a fingerprint identification apparatus comprising:

communication means for communicating with said host computer (see col. 12, lines 20-23);

processing control means for executing a predetermined processing according to the instruction command input from said host computer by said communication means (see col. 11, lines 47-50);

fingerprint detection means for detecting a fingerprint and for generating fingerprint data (see col. 11, lines 50-52);

storage-information recording means for recording the fingerprint data and storage information related to the fingerprint data (see col. 11, lines 54-56); and

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fingerprint identification means for verifying fingerprint data detected by said fingerprint detection means with the fingerprint data recorded by said storage information recording means (see Fig. 24 and 25, col. 18, lines 30-34).

6. In respect to claims 2, 7, 10 and 14, Pare discloses all the limitations as applied to claims 1, 6, 9 and 13 above. Pare further discloses:

“said storage-information recording means allows recorded storage information to be accessed only once immediately after the fingerprint-identification result is affirmative (see Fig. 24).

7. In respect to claims 3-4, 8, 11-12, and 16 Pare discloses all the limitations as applied in claims 1, 6, 9 and 13 above, Pare further discloses:

“said storage-information recording means stores a private key generated by the public-key encryption method (see col. 22, lines 27-35);

“said fingerprint identification apparatus further comprises encryption processing means for generating an encryption key, for performing encryption by the use of the encryption key, and for performing decryption” (col. 21, lines 35-45).

8. In respect to claims 5 and 15, Pare discloses all the limitations as applied to claim 4 and 13 above. Pare further discloses:

“said encryption processing means generates a public key and a private key according to the public key encryption method, and decrypts an encrypted text by the use of the private key” (see col. 21, lines 35-40 and col. 22, lines 30-35).

### ***Conclusion***

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tomko et al. Discloses a biometric controlled key generation that provide unique number for use with PIN operated machines or public key cryptography system is generated by manipulation of fingerprint information of a subscriber.

Davis et al. Discloses an apparatus and method for securing captured data transmitted between two sources.

Holloway discloses a transaction processing system comprises at least one transaction terminal having means to receive characteristic data from a user.

Piosenka et al. Discloses an unforgeable personal identification system.

Shockley et al. discloses a method and system for certificate based alias detection.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran whose telephone number is (703) 305-7690. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (703) 308-4789. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7240 for regular communications and (703) 746-7240 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Examiner Tongoc Tran  
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TT  
August 22, 2003

*Matthew D. Smithers*  
**MATTHEW SMITHERS**  
**PRIMARY EXAMINER**  
*Art Unit 2134*